

REMARKS/ARGUMENTS

Claims 1-7 are pending in the present application. Claims 1-6 were amended; no claims were cancelled; Claims 8 and 9 were added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Office Action has rejected claims 1-7 under 35 U.S.C. § 102 as being anticipated by Raghunandan, System for Directing E-Mail to Selected Recipients by Applying Transmission Control Directives on Aliases Identifying Lists of Recipients to Exclude or Include Recipients, U.S. Patent No. 6,721,785, April 13, 2004, (hereinafter "*Raghunandan*"). This rejection is respectfully traversed.

Regarding claim 1, the Office Action states:

As to claim 1, Raghunandan teaches a method of sending an electronic mail (e-mail) message, comprising, under the control of a mail user agent (column 3 lines 5-13. Raghunandan describes a method for transmitting email...including providing transmission control directives by the user.):

having a user providing an indication of e-mail addresses of intended message recipients (column 3 lines 5-12 teach "A method for transmitting e-mail to a plurality of recipients identified by one or more aliases in identified list or lists of recipients." Which is controlled through "directives by the user".), and

based on said indication by the user, generating a list of destination e-mail addresses (column 3 lines 5-25 teaches aliases are provided as the recipients and are expanded if it includes one or more aliases that are nested in an alias. Furthermore an alias is defined in column 2 lines 1-2 "an alias may correspond to a group of email addresses and may further make reference to other aliases.), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (column 3 lines 20-24 teach "applying each said parsed transmission control directive on said aliases in said identified list or lists of recipients so as to exclude or include a recipient or a group of recipients in said identified list or lists."), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (column 3, lines 26-28 teach "The recipients are included or excluded from said identified list or lists based on the order in which the inclusion or exclusion is defined.").

Office Action dated September 27, 2007, pp. 3-4.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-*

Clark Corp., 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

Claim 1, which is representative of claims 4 and 6 with regards to similarly recited subject matter, recites:

1. A computer-implemented method of using a graphical user interface of a local mail user agent for sending an electronic mail (e-mail) message, comprising:
 - prompting a user to provide a first input in a first input area of the graphical user interface, wherein the first input comprises an indication of e-mail addresses of intended message recipients;
 - responsive to receiving the first input, generating a list of destination e-mail addresses based on said indication;
 - prompting the user to provide a second input in a second input area of the graphical user interface, wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses;
 - responsive to receiving the second input, modifying, by the local mail user agent, the list of destination e-mail addresses to exclude the at least one e-mail address, forming a modified list; and
 - sending the e-mail message in accordance with the modified list.

Raghunandan fails to anticipate amended independent claim 1 as *Raghunandan* fails to teach a graphical user interface for generating an email with features of “prompting a user to provide a first input in a first input area of the graphical user interface, wherein the first input comprises an indication of e-mail addresses of intended message recipients,” and “prompting the user to provide a second input in a second input area of the graphical user interface, wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses.” The Office Action does not cite to any portion of *Raghunandan* as teaching these features. *Raghunandan*, in column 5, lines 35-67, explains that a user inputs a list of email addresses along with a set of e-mail transmission directives through an input device. *Raghunandan* does not get more specific regarding how the user inputs the email address and email transmission directives. Thus, *Raghunandan* does not teach a method “of using a graphical user interface of a local mail user agent for sending an electronic mail (e-mail) message” or “prompting a user to provide a first input in a first input area of the graphical user interface,” or “prompting the user to provide a second input in a second input area of the graphical user interface.”

Further, *Raghunandan* does not teach, “wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses.” Rather, *Raghunandan* teaches that the e-mail transmission directives comprise a set of commands, some of which may be selection commands. If there are selection commands, then the list of e-mail address are parsed and arranged into an array. As the array is read, a determination is made as to whether the directive is an inclusion directive or exclusion directive. If the directive is an exclusion directive, then an e-mail address

corresponding to the directive is deleted from the list of e-mail addresses. Conversely, claim 1 recites, “wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses.” Thus, *Raghunandan* fails to teach the feature of “wherein the second input comprises an indication of at least one e-mail address to be excluded from the list of destination e-mail addresses.”

Therefore, for at least the reasons set forth above, Applicants submit that claim 1 is in condition for allowance over the *Raghunandan* reference, as the *Raghunandan* reference fails to teach all the features of claim 1. Further, as claim 1 is representative of claims 4 and 6, the same distinctions between claim 1 and *Raghunandan* apply to these claims as well. Therefore, Applicants submit that amended independent claims 1, 4, and 6 are in condition for allowance over the cited reference, because the reference fails to anticipate claims 1, 4, and 6. Since claims 2, 3, 5, and 7 depend from claims 1, 4, and 6, the same distinctions between *Raghunandan* and the claimed invention in claims 1, 4, and 6 apply for these claims. Therefore, Applicants submit that claims 2, 3, 5, and 7 are also in condition for allowance over *Raghunandan* at least by virtue of depending from an allowable claim.

Therefore, the rejection of claims 1-7 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 102, Anticipation

The Office Action has rejected claims 1-7 under 35 U.S.C. § 102 as being anticipated by *Kulkarni*, Method of Transmitting an Electronic Mail Message, U.S. Patent Publication No. 2004/0093382, May 13, 2004, (hereinafter “*Kulkarni*”). This rejection is respectfully traversed.

Regarding claim 1, the Office Action states:

As to claim 1, *Kulkarni* teaches a method of sending an electronic mail (e-mail) message, comprising, under the control of a mail user agent (*Kulkarni*'s abstract teaches "A method of transmitting an electronic mail message addressed to a group of recipients using a group alias by temporarily excluding a member from the group alias without modifying the group alias is provided."):

having a user providing an indication of e-mail addresses of intended message recipients (Paragraph [0007] teaches "According to the present invention, the e-mail message is composed in a manner known in the art, including specifying at least a group alias for addressing the group of recipients."), and

based on said indication by the user, generating a list of destination e-mail addresses (Paragraph [0007] teaches "The message is first transmitted from a first mail server to a second mail server for resolving the group alias into a list of individual addresses."), and

causing the message to be electronically delivered to each of the e-mail addresses in the list, characterised by comprising:

enabling the user providing an indication of at least one excluded e-mail address (Paragraph [0007] teaches "where at least one group member is temporarily excluded from receiving the current message"), and

modifying the list so that the message is not delivered to the at least one excluded e-mail address (Paragraph [0007] teaches "The excluded member is then located within the list of individual addresses and temporarily removed from the list before transmitting the message to the remaining addresses.").

Office Action dated September 27, 2007, pp. 9-10.

Kulkarni fails to anticipate amended independent claim 1 as *Kulkarni* fails to teach the feature of "responsive to receiving the second input, modifying, by the local mail user agent, the list of destination e-mail addresses to exclude the at least one e-mail address, forming a modified list." Paragraph [0007] of *Kulkarni* states that "[t]he message is first transmitted from a first mail server to a second mail server for resolving the group alias into a list of individual addresses. The excluded member is then located within the list of individual addresses and temporarily removed from the list before transmitting the message to the remaining addresses." Thus, *Kulkarni* teaches that the modification of the list recipients is performed on an e-mail server and by an e-mail agent that are remote to the system wherein the e-mail was generated and the list of recipients was entered. In contradistinction, claim 1 recites that the list of recipients is modified by a local mail user agent, the same mail user agent that was used to input the addresses and generate the e-mail. Therefore, *Kulkarni* fails to teach the feature of "responsive to receiving the second input, modifying, by the local mail user agent, the list of destination e-mail addresses to exclude the at least one e-mail address, forming a modified list."

Therefore, for at least the reasons set forth above, Applicants submit that claim 1 is in condition for allowance over the *Kulkarni* reference, as the *Kulkarni* reference fails to teach all the features of claim 1. Further, as claim 1 is representative of claims 4 and 6, the same distinctions between claim 1 and *Kulkarni* apply to these claims as well. Therefore, Applicants submit that amended independent claims 1, 4, and 6 are in condition for allowance over the cited reference, because the reference fails to anticipate claims 1, 4, and 6. Since claims 2, 3, 5, and 7 depend from claims 1, 4, and 6, the same distinctions between *Kulkarni* and the claimed invention in claims 1, 4, and 6 apply for these claims. Therefore, Applicants submit that claims 2, 3, 5, and 7 are also in condition for allowance over *Kulkarni* at least by virtue of depending from an allowable claim.

Therefore, the rejection of claims 1-7 under 35 U.S.C. § 102 has been overcome.

III. Objection to Claims

The Examiner objected to claims 1 and 4 because of certain informalities. In particular, the word "characterized" was misspelled. Applicants have amended the claims and eliminated the misspelled words. Thus, Applicants submit that the objections to claims 1 and 4 have been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: December 18, 2007

Respectfully submitted,

/Gerald H. Glanzman/

Gerald H. Glanzman
Reg. No. 25,035
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants

GG/blj